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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/635,068	08/06/2003	John Larsen	38494-00217	1325

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LEWIS AND ROCA LLP  
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PHOENIX, AZ 85004-4429

EXAMINER
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LEMIEUX, JESSICA

ART UNIT	PAPER NUMBER
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4172

MAIL DATE	DELIVERY MODE
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10/29/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/635,068

Applicant(s)

LARSEN ET AL.

Examiner

Jessica L. Lemieux

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 08/06/2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 04/29/2004.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Priority*

Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 119(e) and 120 as follows:

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

The disclosure of the prior-filed application, Application No. 10/281477, fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application. Claims 1-30 disclose management of a degree of variation to the decision-making process that does not have support in the prior applications. Accordingly claims 1-30 are not entitled to the benefit of the earlier application and instead are entitled to the August 6<sup>th</sup>, 2003 filing date for purposes of applying prior art.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 11 and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With regards to claims 1, 11 and 21 "receiving input of intangible impact" is vague and indefinite. Examiner notes that the impact of intangibles is a subjective measurement.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 5-6, 10-13, 15-16, 20-23, and 25-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ten3 Online Business Coach- Project Management: Business Case analysis (hereinafter Ten3) in view of US Patent Application US 2002/0169658 to Adler (hereinafter Adler).

As per claim 1, 11 and 21

Ten3 discloses receiving input of cost information (cash flows in) to implement said business case, second receiving input of financial benefit information (cash flows

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out) estimating a financial benefit afforded by adoption of said business case (page 2: cost-benefit analysis), third receiving input of risk information (risk analysis) estimating a risk associated with adoption of said business plan (page 2: sensitivity, risks, and contingencies), fourth receiving input of strategic impact (strategic alignment) of adoption of said business plan on one or more strategic goals of said organization (page 1, description of the project), fifth receiving input of intangible impact (non-quantitative factors) of adoption of said business plan (page 2: cost-benefit analysis), computing said business value in conformity with said cost information, financial benefit information, risk information, intangible impact and strategic impact information (project selection) (page 1: why business case analysis);

Ten3 does not specifically teach gathering data for estimating a variation of actual values corresponding to one or more of said cost information, financial benefit information, risk information and strategic impact information and updating said computed business value in conformity with said gathered data.

Adler discloses gathering data for estimating a variation of actual values corresponding to one or more of said cost information, financial benefit information, risk information and strategic impact information and updating said computed business value in conformity with said gathered data (page 4, paragraph [0032], lines 11-18). Examiner notes that variation as per applicant's specification includes an adjustment based on actual business case performance (page 1, paragraph [0011], lines 7-13).

Therefore it would have been obvious to one skilled in the art at the time the invention was made to gather data for estimating a variation of actual values corresponding to one or more of said cost information, financial benefit information, risk information and strategic impact information and updating said computed business value in conformity with said gathered data as disclosed by Adler to increase the accuracy of forecasts through refinement of previous decisions.

As per claim 2, 12 and 22

Ten3 discloses gathering confidence (risk analysis) parameters reflecting confidence in one or more of said cost information, financial benefit information, risk information, intangible impact and strategic impact information, in response to user input from users providing objective evaluation of said actual values against said input cost information, financial benefit information, risk information and strategic impact information (page 2, Sensitivity, Risks, and Contingencies). Examiner notes risk is a measure of confidence, a change in risk causes a change in confidence that a certain result will transpire. Examiner also notes that an outline for constructing a business case would require a user to input confidence (risk) information from their evaluations.

As per claim 3, 13 and 23

Ten3 discloses gathering volatility (sensitivity analysis) parameters reflecting a volatility of one or more of said cost information, financial benefit information, risk information, intangible impact and strategic impact information, and further comprising performing a statistical analysis on said computed business value in conformity with

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said volatility parameters, whereby said business value is adjusted for evaluation against other business cases (page 2, Sensitivity, Risks, and Contingencies).

As per claim 5, 15 and 25

Ten3 discloses gathering interdependency (competitive analysis) parameters reflecting a variation of one or more of said cost information, financial benefit information, risk information, intangible impact and strategic impact information, as a function of adoption of one or more other business cases (page 2, Market, Customers, and Competition).

As per claim 6, 16 and 26

Ten3 does not specifically teach gathering historical data reflecting a variation of one or more of said cost information, financial benefit information, risk information, intangible impact and strategic impact information after adoption of said business cases, whereby said business case is evaluated on an on-going basis.

Adler discloses gathering historical data reflecting a variation of one or more of said cost information, financial benefit information, risk information, intangible impact and strategic impact information after adoption of said business cases, whereby said business case is evaluated on an on-going basis (page 4, paragraph [0032], lines 11-18).

Therefore it would have been obvious to one skilled in the art at the time the invention was made to gather historical data reflecting a variation of one or more of said cost information, financial benefit information, risk information, intangible impact and strategic impact information after adoption of said business cases, whereby said business case is evaluated on an on-going basis as disclosed by Adler so that strategies can be assessed and modified as needed.

As per claims 10, 20 and 30

Ten3 discloses repeating said steps of first receiving, second receiving, third receiving, fourth receiving, fifth receiving and computing for each of a plurality of business cases (page 1: generic outline). Examiner notes that a generic outline is designed for use with either one or a plurality of cases.

Adler teaches generating a graphical depiction of placement of said computed business values (decision options) versus risk (metrics), whereby a system user can view the relative merits of said plurality of business cases (Figure 1 and page 8, paragraph [0075]).

Therefore it would have been obvious to one skilled in the art at the time the invention was made to generate a graphical depiction of placement of said computed business values (decision options) versus risk (metrics), whereby a system user can view the relative merits of said plurality of business cases as taught by Adler so that the process of assessing and comparing business cases can be done more effectively and efficiently as different business cases can be assessed side by side.

As per claim 7, 17 and 27

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Ten3 discloses repeating said steps of first receiving, second receiving, third receiving, fourth receiving, fifth receiving and computing for each of a plurality of business cases (page 1: generic outline), receiving sixth input of a fixed acceptable risk value (risk analysis) (page 2: sensitivity, risks, and contingencies). Examiner notes that a generic outline is designed for use with either one or a plurality of cases. Examiner also notes that where risks are identified all risks variable and fixed risks are encompassed.

Adler teaches selecting an efficient portfolio maximizing a total of said financial benefit information from a total of said cost information (page 4, paragraph [0032], lines 8-11).

Therefore it would have been obvious to one skilled in the art at the time the invention was made to select an efficient portfolio maximizing a total of said financial benefit information from a total of said cost information as taught by Adler in order to make the strategic decisions.

Claims 4, 14 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ten3 Online Business Coach- Project Management: Business Case analysis (hereinafter Ten3) in view of US Patent Application US 2002/0169658 to Adler (hereinafter Adler) and further in view of Crystal Ball: Real Options Analysis Toolkit (hereinafter Crystal Ball).

As per claim 4, 14 and 24

Ten3 does not specifically teach a real options analysis.

Crystal Ball discloses a real options analysis (page 1).

Therefore it would have been obvious to one skilled in the art at the time the invention was made to incorporate a real options analysis as taught by Crystal Ball to identify, value, prioritize and manage their strategic opportunities.

Claims 4, 14 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ten3 Online Business Coach- Project Management: Business Case analysis (hereinafter Ten3) in view of US Patent Application US 2002/0169658 to Adler (hereinafter Adler) and further in view of Official Notice.

As per claim 8, 18 and 28

Ten3 discloses providing a series of questions relating to one or more of said cost information (cash flows in), financial benefit information (cash flows out), risk information (risk analysis), intangible impact (non-quantitative factors) and strategic

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impact information (strategic alignment) (pages 1-3). Examiner notes that an outline for constructing a business case requires users to input information, an indirect question format.

Ten3 does not specifically teach each of said questions has an answer selectable from a list of answers, and wherein each of said answers has an associated weighted value for adjusting an associated one of said cost information, financial benefit information, risk information, intangible impact and strategic impact information and collecting said weighted values selected in response to said series of questions, whereby said variation is estimated in conformity with said collected weighted values.

Adler discloses providing a series of questions (survey) relating to one or more of said cost information, financial benefit information, risk information, intangible impact and strategic impact information (page 2, paragraph [0007], lines 6-9). Adler also discloses answers that have an associated weighted value (quantitative decision criteria and their relative weights) for adjusting an associated one of said cost information, financial benefit information, risk information, intangible impact and strategic impact information collecting said weighted values selected in response to said series of questions whereby said variation is estimated in conformity with said collected weighted values (page 1, paragraph [0007], lines 21-25). Examiner notes that collection of information and using that information to update existing information is an inherent step for an analysis and to determine relationships and dependencies. Examiner also notes that variation as per applicant's specification includes an adjustment based questionnaire data (page 1, paragraph [0011], lines 7-13).

Official notice is given that wherein each of said questions has an answer selectable from a list of answers is obvious and well known in the art.

Therefore it would have been obvious to one skilled in the art at the time the invention was made that each of said questions has an answer selectable from a list of answers, and wherein each of said answers has an associated weighted value for adjusting an associated one of said cost information, financial benefit information, risk information, intangible impact and strategic impact information and collecting said weighted values selected in response to said series of questions, whereby said variation is estimated in conformity with said collected weighted values as taught by Adler and official notice as an efficient and consistent means to collect information and make strategic decisions.

As per claims 9, 19 and 29

Ten3 discloses a set of questions relating to one of said cost information (cash flows in), financial benefit information (cash flows out), risk information (risk analysis), intangible impact (non-quantitative factors) and strategic impact information (strategic alignment), financial benefit information, risk information, intangible impact and strategic impact information (pages 1-3). Examiner notes that an outline for constructing a business case requires users to input information, an indirect question format.

Ten3 does not specifically teach issuing said series of questions to a plurality of system users wherein said collecting collects said weighted values from responses of said plurality of system users and averaging said weighted values for each of a plurality



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of sets of questions, and wherein said updating updates each of said cost information, financial benefit information, risk information, intangible impact and strategic impact information in conformity with results of said averaging.

Adler discloses issuing said series of questions (survey) to a plurality of system users (page 2, paragraph [0007], lines 6-9). Adler also discloses answers that have an associated weighted value (quantitative decision criteria and their relative weights) and collecting said weighted values from responses of said plurality of system users and updating information in conformity with results (page 1, paragraph [0007], lines 21-25). Examiner notes that collection of information and using that information to update existing information is an inherent step for an analysis and to determine relationships and dependencies.

Official notice is given that averaging weighted values for each of a plurality of sets of questions is obvious and well known in the art.

Therefore it would have been obvious to one skilled in the art at the time the invention was made that issuing said series of questions to a plurality of system users wherein said collecting collects said weighted values from responses of said plurality of system users and averaging said weighted values for each of a plurality of sets of questions, and wherein said updating updates each of said cost information, financial benefit information, risk information, intangible impact and strategic impact information in conformity with results of said averaging as taught by Adler and Official notice as an efficient and consistent means to collect information and make strategic decisions.

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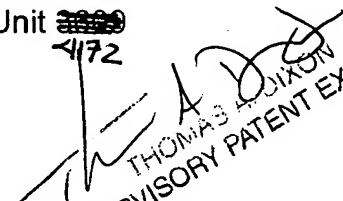
### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jessica L. Lemieux whose telephone number is 571-270-3445. The examiner can normally be reached on Monday-Thursday 8AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Dixon can be reached on 571-272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jessica L Lemieux  
Examiner  
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THOMAS A. DIXON  
SUPERVISORY PATENT EXAMINER